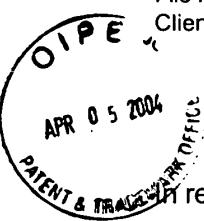


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A.W.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



re Application of
GARRISON, et al.

Application No: 08/994,363

Group Art Unit: 2175

Filed: December 19, 1997

Examiner: S. Rimell

For: ELECTRONIC BILL PAYMENT USING ACCOUNT RANGING TO DETERMINE
THE APPROPRIATE ONE OF MULTIPLE PAYMENT REMITTANCE CENTERS
OF A SINGLE PAYEE

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted (in triplicate) in support of the Notice of Appeal filed
filed February 5, 2004 of the finally rejected claims as set forth in the final Official Action
dated October 6, 2003.

Void date: 04/06/2004 SSITHIB1
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I. REAL PARTY IN INTEREST

CheckFree Services Corporation, is the assignee of all rights in the subject
application. The Assignment was filed with the United States Patent and Trademark
Office on December 4, 2003, but is not yet recorded by the United States Patent and
Trademark Office.

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II. RELATED APPEALS AND INTERFERENCES

Related Application Serial Number 08/994,047 (Attorney Docket 3350-001, is also currently under appeal.

III. STATUS OF CLAIMS

Claims 1-24 are pending in this application, of which claims 1, 6, 11 and 16 are independent. Claims 4 and 9 are objected to, but have been deemed allowable if rewritten in independent form. Accordingly, the final rejection of each of claims 1-3, 5-8, and 10-24 are subject to appeal.

IV. STATUS OF AMENDMENTS

Amendments were filed on November 30, 1999 and November 29, 2000, a prior Appeal Brief was filed on January 9, 2002 (resulting in a withdrawal of the final rejection of the claims on April 17, 2003), a further amendment was filed on July 17, 2003, and a Request for Reconsideration was filed on January 6, 2004.

V. SUMMARY OF INVENTION

The present application is directed to a computer implemented payment remittance processing technique for determining a proper payee remittance center based upon a payor account number with the payee.

As summarized on page 6, line 16, through page 7, line 11, in a preferred embodiment of the invention, a payment request to pay a payee having multiple remittance centers is transmitted from a first network station, e.g. a payor station. A second network station, e.g. a payment processing server, receives the transmitted payment request and processes the request to identify a payor account number with the payee. The second network station then processes the identified payor account number to select one of the multiple remittance centers associated with the payee to which payment is to be made. Additional aspects of the invention are also disclosed and claimed, as will be summarized below.

As recited in claim 1 and described in the context of a preferred implementation with reference to Figures 2 and 5, page 13, line 3, through page 16, line 21, and page 19, line 14, through page 21, line 7, a computer implemented remittance payment process includes receiving a payor (e.g. a consumer 8) request to make a payment to a payee (e.g. a merchant represented by merchant system 4 and as in step 51 of Figure 5 described at page 13, line 25, through page 14, line 1). The payee has a plurality of remittance centers (e.g. as described on page 19, line 23, through page 20, line 1). The payment request is processed to identify the payor account number with the payee (page 14, lines 6-9, and page 15, lines 17-21, page 16, lines 4-6, and page 19, lines 14-20). The identified payor account number is processed (e.g. by processor 17 of RPP 3 in steps 53 and 55 of Figure 5, as described on page 20, lines 1-24) to select a single remittance center of the plurality of remittance centers to which payment is to be made.

Remittance advice for the payment is directed to the payee at the selected single remittance center (e.g. as in step 58 of Figure 5, and as described on page 20, lines 3-4).

As recited in claim 2, the account number is preferably processed to identify information included in the account number which corresponds to the single remittance center (e.g. as described on page 7, lines 6-7, page 19, lines 17-20, and page 20, lines 10-17).

According to claim 3, the identified information included in the account number includes one or more alphanumeric characters (e.g. as described on page 7, lines 8-11).

According to claim 5, and with reference to Figure 6 and page 21, line 8, through page 23, line 17, alteration rules (e.g. alteration rules 44 of Figure 6) for each payee indicating a format in which that payee is to receive an account number are stored (e.g. in merchant database 18 and as described on page 22, line 24, through page 23, line 2). The account number is transformed into an altered account number according to the alteration rules (e.g. by the RPP 3 in step 46 using alteration rules 44 of Figure 6, as described on page 23, lines 2-17) into an altered account number according to the alteration rules (e.g. alteration rules 44 of Figure 6).

According to claim 10, a verification unit (e.g. the RPP 3) verifies that the account number conforms to validation rules (e.g. validation templates 40, in step 42 of Figure 6 as described on page 22, lines 12-20), and a modification unit (e.g. the RPP 3) alters

the account number according to alteration rules (e.g. alteration rules 44 of Figure 6), expressing processing requirements of the payee (e.g. in step 46 of Figure 6 as described on page 22, line 21, through page 22, line 6, to create an altered account number (e.g. altered account number 47 of Figure 6).

In accordance with claim 21, the payment (e.g. payment 24 of Figure 2) is directed to other than the single remittance center (e.g. to the merchant's bank 5 of Figure 1, via the ACH network 26 of Figure 2) as described on page 14, lines 10-21.

In view of the above, a further description of the elements of system claims 6-8 and 22, system claims 16-20 and 24, and software claims 11-15 and 23 is considered to be unnecessary.

VI. ISSUES

Whether claims 1-3, 56-8, 10-13, 15-18 and 20-24 are anticipated under 35 USC §102(e) by Kolling, et al. (U.S. Patent No. 5,920,847).

Whether claims 14 and 19 are obvious under 35 USC §103(a) over Kolling, et al.

VII. BRIEF DESCRIPTION OF THE PRIOR ART REFERENCE

Kolling, et al. (U.S. Patent No. 5,920,847) discloses a C-B "(consumer-biller)" account (see column 3, lines 56-62). Kolling processes a BRN (i.e. biller reference number), not the C-B account number, to identify and select a specific biller bank (e.g. bank B of Kolling Figure 4) to which the consumer's bank (e.g. bank C of Kolling Figure 4)

directs the payment. See for example column 16, lines 48-50. As disclosed, the BRN is an identifier which may be used by the biller to identify the payee, and there is only a single BRN which is used by all Kolling's billers to identify the individual payee. Hence, the BRN is not unique to any particular biller. As also disclosed by Kolling, Bank C is the consumer's bank and hence has no association with the biller. Furthermore, there is no selection in Kolling between Bank C and Bank B (see, for example, column 15, lines 21-26).

Accordingly, in Kolling the BRN rather than the C-B account number (i.e. the payor account number with the payee) is processed to select a bank (i.e. biller's bank B), from a group of banks comprised of the biller's bank and banks of other billers. The payment from the consumer's bank C is to be directed to the selected bank (i.e. biller's bank B).

As additionally described by Kolling in column 15, lines 34-36, the biller's bank B provides biller B (i.e. the biller B remittance center) with an A/R data file 40 (which corresponds to remittance advice) for the payment made by consumer's bank C on behalf of the payor (e.g. consumer C). Furthermore, as described by Kolling in column 16, line 61, through column 17, line 7, of Kolling, the A/R data file 40 is passed from the billers Bank B to the biller itself (i.e. the single biller remittance center).

In summary, Kolling processes a BRN of the biller to identify a BID which is used to select a particular bank from the banks of the particular biller and other billers. The payment and bank remittance advice are directed to the selected biller's bank. The biller's bank then processes the received bank remittance advice to generate the A/R data file

(corresponding to biller remittance advice) which is directed to the biller's single remittance center.

VIII. THE REJECTION

In the final Official Action issued October 6, 2003, claims 1-3, 5-8, 10-13, 15-18 and 20-24 stand rejected as anticipated under 35 USC §102(e) by Kolling, et al. (U.S. Patent No. 5,920,847). Claims 14 and 19 stand rejected as obvious under 35 USC §103(a) over Kolling, et al.

No Advisory Action has been received in response to the Request for Reconsideration filed on January 6, 2004.

IX. GROUPING OF CLAIMS

Claims 1-24 are pending in this application. Claims 1-3, 5-8, 10-24 stand finally rejected and subject to this appeal. Claims 4 and 9 are objected as depending from a rejected base claim, but are otherwise deemed allowable.

Rejected claims 1, 6, 11 and 16 are independent. Accordingly, the various claimed embodiments/implementations of the invention are defined within groupings of claims (i) 1-3, 5 and 21, (ii) 6-8, 10 and 22, (iii) 11-15 and 23, and 16-20 and 24. However, the claims of each group do not stand or fall together. Each of at least claims 1, 6, 11, 16, 21, 22, 23, and 24 recites features that form an independent basis for allowance. Hence, for purposes of this appeal claims 1-3 and 5 can be considered to stand and fall together; claims 6-8 and 10 can be considered to stand and fall together;

claims 11-15 can be considered to stand and fall together; and claims 16-20 can be considered to stand and fall together, and each of claims 21, 22, 23, and 24 stands and falls alone.

X. ARGUMENT

Claims 1-3, 5-8, 10-13, 15-18 and 20-24 stand finally rejected as anticipated under 35 USC §102(e) by Kolling, et al. (U.S. Patent No. 5,920,847). Claims 14 and 19 stand finally rejected as obvious under 35 USC §103(a) over Kolling, et al. Appellants respectfully traverse the rejections based on the prior art applied against the claims now pending on appeal.

As discussed below in detail, it is respectfully submitted that the final rejection lacks the requisite supporting factual basis and/or reasonable rationale. Further still, it is respectfully submitted that the art applied in rejecting the claims neither teaches nor suggests the claimed invention. It is also respectfully submitted that recited limitations have been ignored, the relied upon art has been construed in a manner inconsistent with its own teaching and the rejection is at best based on an improper hindsight reconstruction of the claimed invention.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 223 USPQ 785 (Fed. Cir. 1984).

The limitations required by the claims cannot be ignored. See In re Wilson, 165 USPQ 494 (CCPA 1970). All claim limitation, including those that are functional, must be considered. See In re Oelrich, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 170 USPQ 330 (CCPA 1971).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). That is, objective evidence must be presented by the Examiner in support of the rejection. Without such support, the rejection is improper per se.

In accordance with the present invention as recited in independent claims 1, 6, 11, and 16, payment requests are processed to identify a payor account number with a payee. This account number corresponds to the C-B "(consumer-biller)" account described in Kolling (see column 3, lines 56-62). The payor account number with the payee is processed to select a single one of multiple remittance centers of the payee to which the payment remittance advice, and optionally the payment itself, is to be forwarded.

On the other hand, as noted by the Examiner, Kolling processes the BRN (i.e. biller reference number), not the C-B account number, to identify and select a specific bank (e.g. the biller's bank B) to which the consumer's bank (e.g. bank C) directs the payment. See

for example column 16, lines 48-50.

Accordingly, in Kolling the BRN rather than the C-B account number (i.e. rather than the payor account number with the payee) is processed to select the payment remittance center for the payment from the consumer's (payor's) bank C to biller's (payee's) bank B.

It is perhaps also worthwhile to note that, as described in column, lines 34-36, biller's (payee's) bank B provides the biller B (i.e. the biller B remittance center) with an A/R data file 40 which corresponds to remittance advice for the payment by the consumer's (payor's) bank C to the biller's (payee's) bank B, on behalf of the consumer C.

In summary, using the terminology of Kolling, according to the present invention recited in each of the independent claims, the consumer's (payor's) bank C would process the C-B account number to select one of multiple remittance centers of the applicable biller to which an A/R data file for a payment made by the consumer's (payor's) bank C on behalf of the consumer C is directed by the consumer's (payor's) bank C.

According to Kolling, on the other hand, the consumer's (payor's) bank C processes a BRN of the biller to identify a BID which is used to select the biller's (payee's) bank B from a group of banks consisting of the biller's (payee's) bank B and the banks of other billers (other payees). The payment and bank remittance advice (not the A/R data or other biller remittance advice) are directed from the consumer's (payor's) bank C to the selected biller bank, i.e. biller's (payee's) bank B. The biller's (payee's) bank B then processes the received bank remittance advice to generate the A/R data file (i.e. the biller

remittance advice) which is directed to the only disclosed biller remittance center (i.e. located at biller C itself).

Accordingly, it is respectfully submitted that each of independent claims 1, 6, 11 and 16 patentably distinguishes over Kolling.

As understood, the rejection of the independent claims is maintained in the final Official Action on the basis that Kolling's biller reference number (BRN) is considered to correspond to the payor account number required by the present claims. However, for the reasons set forth above, this is not, and could not be, the case.

Although, the Examiner correctly notes that the BRN is an identifier which may be used by the all of the consumer's (payor's) bank C to identify the biller (payee), there is only a single BRN which is used by all consumers' (payors') banks to identify a particular biller (payee). Those skilled in the art recognize that a "consumer (payor) account number with a particular biller (payee) is different than all account numbers of other consumers (payors) with that biller (payee). Hence, unlike Kolling's C-B account number (which corresponds to the claimed payor account number with the payee), the BRN is not unique to the consumer (payor) in anyway and therefore cannot correspond to the claimed payor account number with the payee.

Furthermore, because the BRN is not unique to the consumer (payor), it could not possibly be used to select a particular one of a plurality of payment remittance centers of a single biller (payee). That is, such a selection would necessarily require at least two different BRNs to be associated with one biller (payee), and this would be

contrary to the explicit teachings of Kolling. Hence, Kolling lacks any disclosure of BRNs having the type of uniqueness of the payor account number with the payee which allows the account number to be processed in order to select a particular one of a plurality of payment remittance centers of the payee.

Further still, in addition to being incapable of use for making the required selection, even if the BRN could somehow be read to correspond to the required payor account number with the payee, that is not all the claims require. Rather, the present claims also require that the payee have a plurality of remittance centers, that the payor account number with the payee be processed to select one of this plurality of remittance centers and that remittance advice for the payment made on behalf of the payor to the payee be directed to the selected payee remittance center.

As understood, it is contended by the Examiner that, in Kolling, the consumer's (payor's) bank C and biller's (payee's) bank B correspond to the required plurality of payee remittance centers. However, contrary to the Examiner's contention, as disclosed by Kolling, the consumer's (payor's) bank C hence has no association with the biller (payee). Thus, it is entirely unclear how the consumer's bank C could possibly correspond to a second biller (payee) remittance center.

Additionally, even if it consumer's bank C were somehow deemed to correspond to a second biller (payee) remittance center, Kolling fails to disclose any selection between consumer's (payor's) Bank C and biller's (payee's) Bank B (see, for example, column 15, lines 21-26).

Yet further, as described by Kolling in column 16, line 61, through column 17, line 7, of Kolling, the A/R data file 40 (i.e. the remittance advice) is both generated by and forwarded from the biller's (payee's) Bank B to the biller (payee) B itself, which is necessarily the biller (payee) remittance center. It is respectfully submitted that there is nothing within Kolling which suggest that the A/R data file (remittance advice) is passed to a selected one of a plurality of biller (payee) remittance centers, or more particularly, one of a plurality of biller (payee) remittance centers selected on the basis of a consumer (payor) account number identified by processing a consumer (payor) request to make a payment to the biller (payee) on behalf of the consumer (payor).

Further still, it should also be noted that even if consumer's (payor's) Bank C and biller's (payee's) Bank B could be deemed a plurality of remittance centers as claimed, Kolling lacks any disclosure of the directing of biller remittance advice to either of these banks. Indeed, in Kolling, the biller's (payee's) bank B generates the A/R data file (the biller remittance advice. Kolling also lacks any disclosure of a selection between these banks for purposes of directing remittance advice.

Dependent claims 21-24, one of which depends from each of the independent claims, recite the further limitation that the payment itself be directed to other than the single remittance center. As discussed above, according to the present invention, payee remittance advice is directed to a selected payee remittance center whereas payment is optionally directed to a payee bank, for example via the ACH network. According, even if Kolling's bank remittance advice were to somehow be construed to correspond to biller

remittance advice as required in the independent claims, claims 21 would further distinguish on that basis that in Kolling both the payment and bank remittance advice are directed from the consumer's (payor's) bank C to the biller's (payee's) bank B.

Clearly, one having ordinary skill in the art would not have been led by the applied prior art to the claimed invention, since this would be contrary to the applied art's own explicit teachings and would render the applied art unable to accomplish its stated purpose. Thus, there is no teaching, suggestion or inference in the prior art as a whole, which could possibly lead to the presently claimed invention.

The only basis one would have to modify the applied art to meet the presently claimed limitation, is the Applicants' disclosure. Thus, the rejection has made without consideration of all the objective evidence bearing on the issues of anticipation and obviousness, and whether one having ordinary skill in the art would have found the claimed invention, as a whole, anticipated or obvious.

In this particular case, the Examiner has apparently failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art's own teachings and rendering it unable to meet a primary objective. The prior art not only fails to suggest the modifications required to anticipate or make obvious the present claims, but in fact teaches against them. Thus, the applied art cannot anticipate or make obvious the presently claimed invention (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986) and In re Fritch, 23 USPQ 1780 (Fed. Circ. 1992)).

Unquestionably, the prior art did not anticipate or make obvious the invention, as a whole, for which patentability is claimed. The Examiner has not even established that each claimed element is found somewhere in the applied prior art, let alone that the invention as a whole is anticipated or obvious (See Hartness International, Inc. v Simplimatic Engineering Co., 2 USPQ 2d 1826 (Fed. Circ. 1987)).

The record in this case establishes that the Examiner has opted to rely on simplicity and hindsight rather than the proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). Based on the objective evidence, there is no possibility that the applied prior art could be modified so as to result in the combination defined by the claims. Furthermore, there is no objective basis which could support a conclusion that the modifications to the applied prior art necessary to meet the subject claim limitations would have been considered by those skilled in the art either desirable or obvious, since the such modifications would be inconsistent with the prior art's own teachings and stated purpose. Since any such suggestion is absent, the basis for the rejection can only be viewed as a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

Even if the applied prior art could be modified so as to result in the combination defined by the claims (which it is respectfully submitted is not the case, as evidenced above), the applied prior art itself expressly teaches against the modification, and therefore also teaches that such modifications are undesirable and would not have been obvious (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller, 208 USPQ 817

(CCPA 1981)).

Furthermore, the deficiencies in the applied art here cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible. (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)).

Accordingly, it is respectfully submitted that no *prima facie* basis for the rejection of independent claims 1, 6, 11, 16, and 21-24 (and hence their dependencies) has been established.

2. THE APPLIED REFERENCE FAILS TO TEACH THE CLAIMED INVENTION

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Although anticipation requires that only that the claim under attack "read on" something disclosed in the reference, all limitations of the claim must be found in the reference, or "fully met" by it. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Claims 1-3, 5-8, 10-13, 15-18 and 20 stand rejected under 35 USC §102(e), as anticipated by Kolling et al. (U.S. Patent No. 5,920,847).

In view of the above discussion, it is respectfully submitted that the applied prior art lacks:

1) Both a payee having a plurality of payment remittance centers, and processing the account number to select a single remittance center of the plurality remittance

centers, as required by claim 1.

2) Both a payee having a plurality of payment remittance centers, and a processor configured to process the account number to select a single payment remittance center of the plurality of payment remittance centers, as required by claim 6.

3) Both a payee having a plurality of payment remittance centers, and a stored computer program configured to be readable from said computer readable storage medium by a computer and thereby cause the computer to process the account number to select a single payment remittance center of the plurality of payment remittance centers, as required by claim 11.

4) A second network station, representing a payment service provider for receiving the payment information, processing the account number to identify a single remittance center of a plural remittance centers of the payee.

4. THE APPLIED REFERENCE FAILS TO SUGGEST THE CLAIMED INVENTION

In rejecting claims under 35 U.S.C. 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is

required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985).

Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 212 USPQ 323 (CCPA 1981); In re Wilding, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the

full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 208 USPQ 817 (CCPA 1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 208 USPQ 871 (CCPA 1981); In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the

invention has been made is not the test. In re Carroll, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 108 USPQ 326 (CCPA 1956); In re Skoll, 187 USPQ 481 (CCPA 1975).

Again, the issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 230 USPQ 313 (Fed. Cir. 1986), In re Keller, *supra*, and In re Laskowski, 10 USPQ2d 1397 (CAFC 1989).

Claims 14 and 19 stand rejected under 35 USC §103(a), as obvious over Kolling et al.

It is respectfully submitted that, in view of the above, claims 14 and 19 are also distinguishable over the applied prior art.

6. THE REJECTION IS BASED EITHER ON AN IMPROPER HINDSIGHT
RECONSTRUCTION OF THE INVENTION BASED ON THE APPLICATIONS OWN
TEACHINGS OR ON PURE SPECULATION

Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

Inherency requires certainty, not speculation. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 212 USPQ 323 (CCPA 1981); In re Wilding, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding non-patentability (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

As discussed above, the record in this case establishes that the Examiner has opted to rely on simplicity and hindsight rather than the proper criteria for resolving

patentability (*In re Warner*, 154 USPQ 173 (CCPA 1967)). Based on the objective evidence, there is no possibility that the applied prior art could be modified so as to result in the combination defined by the claims. Furthermore, there is no objective basis which could support a conclusion that the applied prior art would have made such modifications desirable or obvious, since the necessary modifications are inconsistent with the prior art's own teachings and stated purpose. Since any such suggestion of the required modification is absent, the basis for the rejection can only be viewed as a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See *In re Deminski* *supra*).

The appealed claims have been rejected without objective factual support or rational. The art cited in support of the rejections has been applied in a manner inconsistent with its own teachings. Express limitations set forth in the claims have been completely or effectively ignored.

The evidence shows that there is nothing in the applied art to support the Examiner's position that the present claims are anticipated or obvious. Hence, at best, it can only be concluded that the rejection of the claims, as set out in the final Official Action, reflects an improper hindsight reconstruct the invention using the inventors own disclosure, or reliance on pure speculation.

CONCLUSION

It is respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejection, (ii) has failed to apply art which teaches or suggests the claimed invention, and (iii) has, at best, attempted to improper reconstruct the invention using the inventors own disclosure or relied on pure speculation in rejecting the claims. Thus, the rejection of the pending claims over the applied prior art is improper.

In summary, Applicants respectfully submit that the applied art does not teach or suggest features recited in each of the rejected independent claims, as well as features recited in the dependent claims, and the Examiner has failed provided reasonable evidence to support a contrary conclusion. Furthermore, it is submitted that the art does not provide any teaching, or suggestion within its teachings, which would lead to the features or advantages of the instant invention, and the claims patentably define over the art. The rejections can therefore only be based on an improper hindsight reconstruction or pure speculation. Thus, the rejection of the pending claims is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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APPENDIX OF CLAIMS UNDER APPEAL

1. A computer implemented remittance payment process, comprising:
 - receiving a payor request to make a payment to a payee having a plurality of payment remittance centers;
 - processing the request to identify a payor account number with the payee;
 - processing the account number to select a single remittance center of the plurality remittance centers; and
 - directing remittance advice for the payment to the payee at the single remittance center.
2. The computer implemented remittance payment process of claim 1, wherein the account number is processed to identify information included in the account number which corresponds to the single remittance center.
3. The computer implemented remittance payment process of claim 2, wherein the identified information included in the account number has one or more alphanumeric characters.
4. The computer implemented remittance payment process of claim 1, further comprising:
 - processing the request to identify payee address data;
 - processing the payee address data to produce an eleven digit zip code for the

payee; and

accessing payee records corresponding to the eleven digit zip code.

5. The computer implemented remittance payment process of claim 1, further comprising:

storing alteration rules for each payee indicating a format in which that payee is to receive an account number; and

transforming the account number into an altered account number according to the alteration rules.

6. A remittance payment system, comprising:

a communicative interface configured to receive a payor request to make payment to a payee having a plurality of payment remittance centers; and

a processor configured to process the payor request to identify a payor account number with a payee and the account number to select a single payment remittance center of the plurality of payment remittance centers, and to generate a signal directing remittance advice for the payment to the payee at the single payment remittance center.

7. The remittance apparatus of claim 6, wherein the processor is further configured to process the account number to identify information included in the account number and to select the single payment remittance center based upon the identified information.

8. The computer implemented remittance payment process of claim 7, wherein the identified information of included in the account number has one or more alphanumeric characters.

9. The remittance apparatus of claim 6, wherein the processor is further configured to process the request to identify payee address data, and further comprising:

- a database including payee records;
- a mapping unit configured to process the payee address data to produce an eleven digit zip code for the payee; and
- a retrieval unit configured to access the database to locate payee records corresponding to the eleven digit zip code.

10. The remittance apparatus of claim 6, further comprising:

- a verification unit to verify that the account number conforms to validation rules indicating expected values for fields of the account number; and
- a modification unit to alter the account number according to alteration rules expressing processing requirements of a the payee to create an altered account number.

11. An article of manufacture for processing payment information, comprising:
 - computer readable storage medium; and
 - a computer program stored on the storage medium;

wherein said stored computer program is configured to be readable from said computer readable storage medium by a computer and thereby cause the computer to:

 - receive a payor request to make payment to a payee having a plurality of payment remittance centers;
 - process the payor request to identify a payor account number with the payee and the account number to select a single payment remittance center of the plurality of payment remittance centers; and
 - generate a signal to direct payment remittance advice for the payment to the payee at the single payment remittance center.

12. The article of manufacture of claim 11, wherein the computer program is further configured to cause the computer to process the account number to identify information included in the account number and to select the single remittance center based upon the identified information.

13. The article of manufacture of claim 12, wherein the identified information of included in the account number has one or more alphanumeric characters.

14. The article of manufacture of claim 11, wherein the computer program is further configured to cause the computer to:

process the payor request to identify payee payment information;
process the payment information to produce an eleven digit zip code for the payee; and
access payee records corresponding to the eleven digit zip code.

15. The article of manufacture of claim 11, wherein the computer programming is further configured to cause the computer to:

transform the account number into an altered account number according to alteration rules for the payee indicating a format in which a the payee expects to receive an the account number.

16. A system for processing payment information, comprising:

a communications network;
a first network station, representing a payor for generating payor payment information, including a name of a payee, address data for the payee, and a payor account number with the payee, and communicating the payment information the network; and

a second network station, representing a payment service provider for receiving the payment information, processing the account number to identify a single remittance

center of a plural remittance centers of the payee, and directing payment remittance advice associated with a payment to the payee at the single remittance center.

17. The system for processing payment information of claim 16, wherein a characteristic identifying the single remittance center is included in the account number.

18. The system for processing payment information of claim 17, wherein the characteristic is one or more alphanumeric characters.

19. The system of claim 16, wherein:

the second network station further processes the payment information to produce an eleven digit zip code for the payee, and accesses payee records corresponding to the eleven digit zip code.

20. The system of claim 16, wherein:

the second network station includes a database storing alteration rules for the payee indicating a format in which that payee is to receive an account number, and transforms the received account number into an altered account number according to the alteration rules.

21. The computer implemented payment remittance process of claim 1, further comprising:

directing the payment to other than the single remittance center.

22. The remittance payment system of claim 6, wherein the processor is further configured to direct the payment to other than the single remittance center.

23. The article of manufacture of claim 11, wherein the computer program is further configured cause the computer generate a signal to direct the payment to other than the single remittance center.

24. The system for processing payment information of claim 16, wherein the second network station is further configured to direct the payment to other than the single remittance center.